

REMARKS**Summary of the Office Action**

Claims 20 and 32-47 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

Claims 20 and 32-47 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Claims 20, 32, 33 and 36-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over TurboTax software as described on a web page cited in the Office Action by the Examiner and allegedly dated 4/24/99 (hereinafter "TurboTax").

Claims 34 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over TurboTax in view of a CDNow.com web page cited in the Office Action by the Examiner and allegedly dated 4/27/99 (hereinafter "CDNow").

Claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over TurboTax in view of an mp3.com web page cited in the Office Action by the Examiner and allegedly dated 1/25/99 (hereinafter "mp3.com").

Claims 40-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over TurboTax in view of mp3.com and further in view of CDNow.

Claims 45, 46 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over TurboTax in view of a Magellan Mapsend and GPS products web page cited in the Office Action by the Examiner and allegedly dated 6/30/99 (hereinafter "Magellan").

Summary of the Response to the Office Action

Applicant has amended claims 20, 32, 34, 37-41 and 45 to differently describe embodiments of the disclosure of the instant application's specification and/or to improve the form of the claims. Claims 46 and 47 are canceled without prejudice or disclaimer. Accordingly, claims 20 and 32-45 remain pending for consideration.

Rejections under 35 U.S.C. §§ 101 and 112 Second Paragraph

Claims 20 and 32-47 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Claims 20 and 32-47 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claims 20, 32, 34, 37-41 and 45 have been amended to improve the form of the claims in response to the Examiner's comments at pages 2-5 of the Office Action. Claims 46 and 47 have been canceled without prejudice or disclaimer, rendering the rejections of these claims moot.

For example, newly-amended independent claim 20 describes a terminal device that is connected to a telecommunication network so as to communicate with a server via a telecommunication network. Applicants respectfully submit that because of the interaction with the server, the terminal device described in independent claim 20 can produce an information data that corresponds to an original complete information data even though the terminal device is provided with a storage medium carrying thereon an incomplete information data. As a result, Applicants respectfully submit that independent claim 20 of the instant application describes a combination of features of a terminal device that result in a practical application.

Applicants respectfully submit that the amendments to claim 45 are supported by the disclosure of the instant application, for example, in Figs. 37-44 and the corresponding description beginning at page 75, line 19 of the specification of the instant application.

Accordingly, Applicants respectfully submit that the claims as newly-amended fully comply with each of 35 U.S.C. § 101 and 35 U.S.C. § 112, second paragraph. As a result, Applicants respectfully request that the rejections under 35 U.S.C. § 101 and 35 U.S.C. § 112, second paragraph be withdrawn.

Rejections under 35 U.S.C. § 103(a)

Claims 20, 32, 33 and 36-38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over TurboTax. Claims 34 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over TurboTax in view of CDNow. Claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over TurboTax in view of mp3.com. Claims 40-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over TurboTax in view of mp3.com and further in view of CDNow. Claims 45, 46 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over TurboTax in view of Magellan.

Applicant has amended claims 20, 32, 37-39 and 45-47 to differently describe embodiments of the disclosure of the instant application's specification and/or to improve the form of the claims. To the extent that these rejections might be deemed to apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

As described in newly-amended independent claim 20 of the instant application, the incomplete information data is obtained by omitting at least one part of data of an

original complete information data. In other words, Applicants respectfully submit that the incomplete information data is incomplete in its data format itself and therefore the incomplete information data itself cannot be decoded.

On the other hand, Applicants respectfully submit that the cited TurboTax software is based on: 1) base software that is to be updated by 2) the updated software. Applicants respectfully submit that both the base software and the updated software in this regard are each respectively complete in data format in themselves and each can thus be treated as a complete software component in themselves, each taken separately, even though the contents of both software types can be combined together for correct, or up-to-date, usage.

As a result, Applicants respectfully submit that the subject invention, as described in newly-amended independent claim 20, is significantly different from the disclosure of TurboTax at least because the incomplete information data described in newly-amended independent claim 20 of the instant application cannot be decoded or treated as correct and complete data. On the other hand, the updated software described in TurboTax is a correct group of data carrying thereon the updated version of the subject software.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 103(a) should be withdrawn because TurboTax does not teach or suggest each feature of independent claim 20, as amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs

that “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).”

Furthermore, Applicants respectfully assert that the dependent claims are allowable at least because of their dependence from independent claim 20, and the reasons set forth above. Moreover, Applicant respectfully submits that the additionally applied references to CDNow, mp3.com and Magellan, each with respect to particular dependent claims, do not cure the deficiencies discussed above with regard to TurboTax.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants’ undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required,

including any required extension of time fees, or credit any overpayment to Deposit

Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP

A handwritten signature in black ink, appearing to read 'Paul A. Fournier', is written over a horizontal line.

By:

Paul A. Fournier
Reg. No. 41,023

Dated: June 4, 2007

Customer No. 055694
Drinker Biddle & Reath LLP
1500 K Street, N.W., Suite 1100
Washington, DC 20005-1209
Tel.: (202) 842-8800
Fax: (202) 842-8465